

REMARKS

This Proposed Amendment is responsive to the Office Action mailed November 24, 2009, which has been carefully considered. Claims 19-38 are pending, with claims 33-38 withdrawn from consideration. Thus, at the time of the Office Action, claims 19-32 were presented for examination.

With this Amendment, claims 19, 20 and 21 have been amended, and claim 22 has been cancelled, without prejudice. Support for the amended claims is found in the originally filed application, particularly at locations identified hereinafter. Accordingly, no new matter has been added.

Reconsideration and allowance of the subject application are respectfully requested for at least the following reasons.

Interview Request Form

With the filing of this Proposed Amendment, Applicant has filed an Applicant Initiated Interview Request Form (PTOL-413A) proposing an interview date within 2 months from the filing of the request.

35 U.S.C. §112 Rejection

Claims 20 and 21 stand rejected under 35 U.S.C. §112, second paragraph. In raising the rejection, the Office Action indicates that each of claims 20 and 21 as currently written would require a second either monopolar or laparoscopic electrosurgical scissors in addition to the scissors recited in claim 19.

In response, Applicant has amended claims 20 and 21 to overcome the 35 U.S.C. §112 rejection. Withdrawal of the rejection is respectfully requested.

35 U.S.C. §102 Rejection

Claims 19-22, 24-29 and 31-32 stand rejected under 35 U.S.C. §102(b) in light of Pennybacker et al., U.S. Patent No. 5,637,110 ("Pennybacker").

Independent claim 19 recites a claim for electrosurgical scissors. Turning to Pennybacker, Applicant does not understand Pennybacker to show electrosurgical scissors in the drawings as indicated by the following:

“The jaw unit 12 comprises a pair of preferably identical jaws 170 (FIG. 20). In the particular embodiment shown, the jaws 170 are dissector jaws having distal end portions 171 which can be brought together for gripping tissue of a patient and moved apart to release same. It is also contemplated that jaws of other types and/or purposes, for example, *scissors jaws (not shown) may be substituted.*” (Col. 9, ll. 48-54) (emphasis added)

...

The very small clearances laterally between the extension tube slot edges, jaw proximal end portions and link necks maximizes the lateral support and hence resistance to bending imparted to the link necks by the sandwiching jaw rear end portions and extension tube slot edges. Slight interference to sliding between the parts is tolerable since it adds to the resistance to bending of the link necks. In a figurative sense, the link necks almost become an interior part of a solid block although one in which they are allowed to translate and pivot in their own plane. In some instances, it may be desirable during surgery to pass an electric cauterizing current through the jaws 170 to patient tissue, for cauterizing same. This may be true in the case of dissector type jaws as well as with jaws of other types, *such as conventional jaws (not shown) capable of scissors-like cutting.* (Col. 14, ll. 46-61) (emphasis added)

Thus, from the foregoing, Pennybacker appears to make clear that “scissor jaws”, as well as “conventional jaws capable of scissors-like cutting”, are not shown in the drawings.

Now, given Pennybacker makes reference to “scissor jaws”, as well as “conventional jaws capable of scissors-like cutting”, neither or which are understood to be shown in the drawings as indicated, *supra*, it would appear that such a device would be different from the device shown in the drawings and, as such, it would appear the Examiner is combining features from different embodiments inasmuch as the rejection relies upon the figures of Pennybacker.

Applicant understands rejections under 35 U.S.C. §102 are proper only when the claimed subject matter is identically disclosed or described in the prior art. See *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). Unless a reference discloses within the four corners of the document not only all the limitations claimed but also all of the limitations *arranged or combined in the same way as recited in the claim*, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. §102. See *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d

1359, 1369 (Fed. Cir. 2008). (emphasis added) Thus, Applicant understands that embodiments of various devices within Pennybacker may not be combined to raise a rejection under 35 U.S.C. §102.

However, without acquiescing to the properness of the foregoing rejection, Applicant has amended claim 19 to expedite prosecution and further distinguish from the art, thus rendering any further discussion of the foregoing rejection against this claim moot. In particular, the Applicant has amended claim 19 to include the feature of “an end effector comprising a first blade member and a second blade member, the first blade member and the second blade member pivotally connected and arranged to cut tissue.¹” Support for the amendment may be found, for example, in paragraph [0057]. Accordingly, no new matter has been entered into the application.

Pennybacker is not understood by the Applicant to disclose all the features of amended claim 19. Here, the intended use of the devices shown in Pennybacker’s drawings is provided as follows:

“The jaw unit 12 comprises a pair of preferably identical jaws 170 (FIG. 20). In the particular embodiment shown, the jaws 170 are dissector jaws having distal end portions 171 which can be brought together **for gripping tissue of a patient and moved apart to release same.**” (Col. 9, ll. 48-52) (emphasis added)

From the foregoing, it may be appreciated by the Examiner that the intended use of the jaw unit 23 shown in the drawings is for gripping tissue when the jaws are brought together and to release tissue when moved apart. Now, to modify the jaws of Pennybacker to cut tissue as opposed to gripping tissue would appear to render Pennybacker unsatisfactory for its intended purpose, as well as change the operation of Pennybacker, which is strongly indicative of non-obviousness. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Now to further distinguish from the art, Applicant has further amended claim 19 to include the feature of the first blade member and second blade member each comprising a distal portion, with at least one of the distal portions further comprising a bulbous portion protruding from the blade. Support for the amendment may be found, for example, in now cancelled claim

22, as well as the figures. Accordingly, no new matter has been entered into the application. Pennybacker is not understood by the Applicant to teach a blade member with a bulbous portion as now recited by amended claim 19. As indicated in the Applicant's specification, in this manner, the distal end surface area of device 22 is increased to provide an appropriate power density for coagulating tissue with a painting motion. Applicant does not understand Pennybacker to provide such a structure or benefit.

35 U.S.C. §103 Rejections

Claim 23 stands rejected under 35 U.S.C. §103(a) in light of Pennybacker and further in view of Levin, U.S. Patent No. 5,827,281 ("Levin"), and claim 30 stands rejected under 35 U.S.C. §103(a) in light of Pennybacker and further in view of Rydell, U.S. Patent No. 5,352,222 ("Rydell").

Applicant has carefully reviewed the secondary references, and neither of the references are understood by the Applicant to provide the missing teachings of Pennybacker to raise a rejection of claim 19 as being unpatentable under 35 U.S.C. §103(a). Applicants respectfully submit that, in view of the foregoing amendments and remarks herein, the rejections under 35 U.S.C. §103(a) has been rendered moot, and respectfully requests the rejections be withdrawn upon reconsideration.

Accordingly, the Applicant believes that it has been demonstrated that the claims herein define over the teachings of the cited references. In view of the foregoing remarks, it is respectfully submitted that independent claim 19 is patentable over Pennybacker, as well as the foregoing secondary references. Allowance of independent claim 19, as well as the pending claims which depend directly or ultimately therefrom, is respectfully requested.

SUMMARY

The Applicant respectfully submits that, in light of the foregoing remarks, and having dealt with all the rejections raised by the Examiner, the claims are in order for allowance. Thus, early allowance is earnestly solicited.

If the Examiner desires personal contact for further disposition of this case, the Examiner is invited to call the undersigned Attorney at 603.668.6560.

In the event there are any fees due, please charge them to our Deposit Account No. 50-
2121.

Respectfully submitted,

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